

Appl. No. : 10/680,523
Filed : October 7, 2003

REMARKS

In the Office Action mailed November 12, 2009, Claims 1-42 were rejected as obvious. Applicant has not amended the claims. Accordingly, Claims 1-42 remain pending in the application. Applicant respectfully requests reconsideration of the application in view of the remarks below.

Discussion of the Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1-4, 6-8, and 10-48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Oscar (U.S. Patent App. Pub. No. 2001/0037216). Claims 5 and 9 were rejected as obvious over Oscar in view of Surwit (U.S. Patent No. 6,980,958).

Applicant respectfully submits that, as stated in the M.P.E.P. at § 2131, “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicant further submits that, as stated in the M.P.E.P. at § 2143, “The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements were known in the prior art.**” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Applicant respectfully submits that Oscar fails to describe at least one feature of each of Claims 1-48.

Claim 1 recites “adjusting, using one or more processors, a patient copayment for at least one medication treatment therapy according to a cost-effectiveness of the medication treatment therapy.” Each of independent Claims 6, 12, 22, 26, 30, 39, and 42 recite a substantially similar feature. Applicant respectfully submits that Oscar does not disclose this feature.

Oscar, at paragraph [0053], discloses a computer system which displays a drug and a list of alternative drugs. For each, an “out of pocket expense” for the drug is displayed. Accordingly, a patient can “make an informed choice, along with his doctor, based on price, efficacy, and safety.” Oscar does not disclose “**adjusting** ... a patient copayment for at least one medication treatment therapy according to a cost-effectiveness of the medication treatment therapy” as recited in Claim 1, but rather, the displayed “out of pocket expense” is **fixed**.

Oscar, at paragraphs [0063]-[0064], discloses a computer system with a “[c]onsultant module 120 [which] includes processing functionality that is specifically helpful to consultants in

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analyzing and constructing pharmacy benefit plans.” The consultant module displays “plan benefits model data based on behavior hypothesis information entered by the consultant.” For example, the “consultant can change the copayment amounts of the benefits structure to see how costs are affected.” However, Oscar does not disclose “adjusting ... a patient copayment ... **according to a cost-effectiveness of the medication treatment therapy**” as recited in Claim 1, but rather, based on “**behavior hypothesis information entered by the consultant.**”

Because Oscar does not disclose “adjusting, using a computer, a patient copayment according to a cost-effectiveness of the medication treatment therapy” as recited in Claim 1, or any of the substantially similar features recited in independent Claims 6, 12, 22, 26, 30, 39, and 42, Applicant respectfully submits that Oscar does not anticipate or render obvious the independent claims. Claims 2-4, 7-11, 13-21, 23-25, 27-29, 31-38, 40-41, and 43-48 depend directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that if an independent claim is not anticipated or rendered obvious, then any claim depending therefrom is also not anticipated or rendered obvious. *See Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296 (Fed. Cir. 2002) (anticipation); *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1256 (Fed. Cir. 1989) (anticipation); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (obviousness). Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §§ 102(e) and 103(a).

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.


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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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